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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,473	05/03/2001	Troy DeFrees-Parrott	TPG 10400	6950

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EXAMINER	
CAPRON, AARON J	
ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 03/10/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/848,473	DEFREES-PARROTT ET AL.	
	Examiner	Art Unit	
	Aaron J. Capron	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 January 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *36-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *36-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is a response to the Amendment received on January 20, 2004, in which claims 36-45 were amended and claims 46-48 were added. Claims ~~46~~ 36-48 are pending.

Terminal Disclaimer

The terminal disclaimer filed on January 20, 2004 disclaiming the terminal portion of any patent granted on this application has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 36, 38, 40-41 and 45-48 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Okuniewicz (U.S. Patent No. 6,585,589).

Referring to claims 36 and 45, Okuniewicz discloses a gaming machine having a base game having a wager input device, a lottery game device comprising a control module having a first mode (4:57-5:13 and 6:7-13) or a second mode of operation (4:57-61); interface circuitry receiving lottery game data from the first mode and the second mode (Figure 1); a display

device; circuitry to activate the lottery game device upon occurrence of a predetermined event (3:46-53); an indicating device; and a player interface device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz.

Referring to claims 37 and 39, Okuniewicz discloses having a bonus/secondary game as a lottery game and/or as a keno game (6:7-13), but does not disclose the lottery game being a live or prerecorded lottery drawing. However, it is notoriously well known within the art of keno games that keno games have been played in a live or pre-recorded format in order to provide a player with the same experience if the player played a regular keno game. One would be motivated to provide these features into Okuniewicz in order to attract players that would normally only participate in keno games by providing normal, realistic keno game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a live into the invention of Okuniewicz in order to attract player that would normally only participate in regular keno games.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz in view of Acres et al. (U.S. Patent No. 6,319,125; hereafter "Acres").

Referring to claim 42, Okuniewicz discloses a method of operating a gaming system including wide area network, but does not disclose a player tracking system. However, Acres discloses network based gaming machines that incorporate a bonus game that tracks player activity and an accounting data systems in order to verify that the bonus game and withdrawals from the gaming machines are authorized, wherein the predetermined event is when the player plays a predetermined cumulative amount of credit (Acres: 9:57-12:56). The two references are analogous since both refer to gaming machines having bonus game features. One would be motivate to combine the references in order to give Okuniewicz a chance to monitor how often a player plays in the casino and determine incentives for the players who play more frequently. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the accounting system and player tracking of Acres into Okuniewicz's invention in order to monitor how often a player plays in the casino and determine incentives for the players who play more frequently.

Claims 43-44 rejected under 35 U.S.C. 103(a) as being unpatentable over Okuniewicz in view of Luciano, Jr. et al. (U.S. Patent No. 6,050,895; "Luciano").

Referring to claims 43-44, Okuniewicz discloses a method of operating a gaming system including wide area network and states that any suitable triggering event may qualify to access the bonus game (3:46-53), but does not specifically disclose the bonus-triggering event being based upon playing for a predetermined amount time. However, Luciano discloses that a bonus

game may be triggered by a predetermined amount of time (8:66-9:15). One would be motivated to combine the references since Okuniewicz discloses that any suitable triggering event can be used to trigger a bonus game. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the bonus-triggering event of Luciano into Okuniewicz since Okuniewicz discloses that any suitable triggering event can be used to trigger a bonus game.

Response to Arguments

Applicant's arguments with respect to claims 36-48 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, see page 16, lines 5-10, filed January 20, 2004, with respect to the rejection(s)of claim(s) 36, 40 and 45 under Vancura have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Okuniewicz.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

JESSICA HARRISON
PRIMARY EXAMINER